

**REMARKS**

Reconsideration of the present application is respectfully requested.

**I. Status of the Claims**

Claim 47 was previously canceled.

Claims 1, 3, 32, and 44 have been amended and no new matter has been added by way of this amendment.

Claims 1-46 are pending.

**II. Telephone Interview**

Applicants would like to thank Examiner Pantuck for all of the courtesies extended in the telephone interview held on June 24, 2005. Applicant would like to thank the Examiner for discussing the claims and the Examiner's indication that the proposed amendments should distinguish over the prior art of record.

**III. Acknowledgment of Allowable Subject Matter**

Applicants thank the Examiner for the acknowledgment of allowable subject matter in claims 14, 15, 22, 35, 36, 41, and 42. The claims are objected to but would be allowed if amended into independent form.

**IV. Rejections under 35 U.S.C. § 102**

Claims 1-12, 17, 21, 24-32, 34, 38-40, and 44-46 stand rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 6,017,354 to Culp et al. ("Culp"). The Examiner contends that Culp discloses every element of the claims. Applicants respectfully traverse the rejection.

Applicants submit that Culp discloses a surgical tool system with memory units disposed in the motor housing of the handpiece of the surgical tool system as stated on column 6, lines 51-52, "two memory units 72 and 74 are fitted in the motor housing 50 of handpiece 32," and shown in Figs. 2 and 3. The motor 52 within the motor housing includes windings, permanent magnets 62, a bearing assembly 64, etc. and it is generally known in the art that the motor and motor housing are not disposable. Culp's surgical tool system includes a "memory which stores data regarding the operating parameters of the handpiece. This data, includes information about the speeds at which any motor internal to the handpiece should be driven," (Abstract, lines 3-6) but does not include memory specific to the end-effector. Culp does not disclose providing a memory on the end-effector itself, allowing different end-effectors to be used with a single hand-piece and the motor included therein.

In contrast, amended claim 1 recites "an end-effector... being selected from the group consisting of a blade, an assembly of a blade and a sheath, shears, scissors and forceps... and a memory disposed in the end-effector." Thus, various medical tools (i.e. surgical blade, sheath, etc.) may be used with a single hand piece and a memory may be provided for each tool. It is generally known in the art that such surgical tools may be removable, interchangeable and/or disposable and that these disposable tools may include a sheath, handle or the like. The invention disposes the memory on the removable/disposable end-effector itself rather than within the motor housing. This

provides an advantage over the prior art, which cannot differentiate between different tools used with the hand-piece.

The memory of the invention may be disposed in the sheath, grip, mount or handle of the end-effector as supported in the Specification on page 39, lines 4-6:

“The memory 400 for an ultrasonic surgical hand piece 30 according to the invention is located in the sheath of the end-effector. Alternatively, the memory device, 301, 302, or 303, can be located in the grip, mount, or handle portion of a shears or shears-like device or other device.”

Alternatively, the memory may be located on the medical tool itself (i.e. blade or shears) as supported in the Specification on page 40, lines 6-8: “the memory and support electronics is connected to a coil, all of which is mounted in or on the blade or shears or end-effector.”

The features of “an end-effector being connectable to said hand piece, and said end-effector being selected from the group consisting of an assembly of a blade and a sheath, shears, scissors and forceps... and a memory disposed in the end-effector” are neither disclosed nor suggested by Culp. Claims 8, 21 and 24-31 depend from claim 1 and are patentable for at least the same reasons as claim 1.

Regarding claims 2, 3, 9, 10, and 12, the memory is disposed in the end-effector, similar to claim 1, which is in contrast to the surgical tool assembly of Culp which discloses a memory within the motor housing of the handpiece. Claims 4 and 6 depend from claim 2, claims 5 and 7 depend from claim 3, claim 11 depends from claim 10 and claim 17 depends from claim 12. These claims are patentable for at least the same reasons as their respective base claims.

Regarding claim 32, the amended claim recites an “end-effector being selected from the group consisting of an assembly of a blade and a sheath, shears, scissors and forceps... and a memory disposed in the end-effector.” Thus the method of claim 32 differs from that of Culp which

discloses reading a memory from the handpiece and the memory does not contain data specific to the end-effector in use. Claims 34 and 38-40 depend from claim 32 and are patentable for at least the same reason as claim 32.

Regarding claim 44, the amended claim recites that “a memory [is] disposed in the end-effector.” Again, this is in contrast to Culp which discloses a memory in the motor housing of the handpiece, which is not a removable or disposable portion of the surgical tool assembly. Claims 45 and 46 depend from claim 44 and are patentable for at least the same reasons as claim 44.

**V. Rejections under 35 U.S.C. § 103**

Claims 18, 19, and 23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Culp in view of U.S. Patent No. 5,400,267 to Denen et al. Claims 20, 24, 37, and 43 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Culp in view of U.S. Patent No. 6,331,181 to Tierney et al. Claims 20 and 33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Culp in view of U.S. Patent No. 6,298,255 to Cordero et al. Lastly, claims 13 and 16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Culp in view of U.S. Patent No. 6,434,507 to Clayton et al. These several rejections are respectfully traversed.

Claims 13, 16, 18-20, 23, and 24 depend from claims 1, 3 and 44, and claims 33, 37, and 43 depend from claim 32. Applicants respectfully submit that Culp does not teach or suggest all the elements of the independent claims. Further, Culp teaches away from any configuration other than his disclosed teaching. Additionally, Denen et al., Tierney et al., Cordero et al., and Clayton et al. do not teach or disclose the elements missing from Culp. Thus, none of the references, either alone

or in combination, teach or suggest all of the elements of the claims. Applicants respectfully request that the rejection be withdrawn.

**CONCLUSION**

Based on the foregoing amendments and remarks, this application should be in condition for allowance. Early passage of this case to issue is respectfully requested. However, if there are any questions regarding this amendment, or the application in general, a telephone call to the undersigned would be appreciated since this would expedite the prosecution of the application for all concerned.

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Respectfully submitted,

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